REMARKS/ARGUMENTS

The Rejection of Claim 14

The rejection under 35 USC § 112, first paragraph is without merit. The disclosure of a "data carrier" supports "computer readable media".

The rejection under 35 USC § 101 is without merit. A computer program is not "non-functional descriptive material". A sales brochure might well be "non-functional descriptive material" but that cannot be said of a computer program.

The Rejection of Claims 1-2, 5-14 and 18-23 based on Owa and Van Oijen

Claims 1-2, 5-14 and 18-23 are rejected as allegedly being obvious over Owa (US Patent 6,348,971) in view of Van Oijen (US Patent 5,918,988). This grounds for rejection is respectfully traversed.

As indicated in the introductory portion of the present application, there is prior art dealing with the selection of printers to handle print jobs. Please note the discussion at paragraphs 0001 - 0010 of the present application. The prior art reference Owa falls into the sort of prior art cited by applicant in that it too does not handle situations where none of the available printers are set up to print a job job with any sort of elegance.

The present application deals with how to handle situations where the available printers are just not adequate to handle a print job. See paragraph 0011 of the present application.

Before comparing Owa and the rejected independent claims, note what Owa teaches when none of the available printers are adequate for the job: consider steps S8 and S18 in Owa's figure 6 – if no printer exists which can handle the print job, Owa's print routine bails out by displaying a message at S9 saying, in effect, no printer can be selected to handle the print job (see col. 6, ll.

1-3). Does Owa tell a human how any of the available printers might be reconfigured to handle the print job? No.

So the Examiner points to a passage in Van Oijen at column 2, lines 1-12, which state:

> "the automatic mode. This is advantageous both in the situation in which such printing systems have to be used at a large number of places with different requirements and in the situation in which print jobs are received from different departments of an organization at a printing system at a central point.
> "One embodiment of a printing system according to the present application includes means for selectively printing print jobs in dependence on the job specifications of the other jobs. In this way it is possible to make the selection of a print job dependent on the other print jobs present at that time."

The Examiner points more specifically to the discussion about selecting print jobs dependent on other print job specifications of other print jobs (see the bold text in the middle of page 6 of the official action).

This quoted passage from Van Oijen is supposed to be relevant to the following limitation of claim 1 (according to the Examiner):

> "when one or more of the print jobs cannot be printed using said at least one printer on the basis of said plurality of different printing configurations, automatically determining at least one reconfiguration of the printer configuration(s) that would be capable of satisfying the printing requirement(s) of said one or more print job(s)"

Van Oijen basically seems to say that print jobs, which share certain points of similarity in their print specifications, are grouped together. That's very nice and that might certainly help with manual jobs in a print shop. But this feature simply does not meet the claim limitation recited above. Just because <u>one</u> print job may be related to the print specification of <u>another</u> print job, it not follow that said <u>one</u> print job "cannot be printed using said at least

one printer on the basis of said plurality of different printing configurations" as claimed or that, as a result, "automatically determining at least one reconfiguration of the printer configuration(s) that would be capable of satisfying the printing requirement(s) of said one or more print job(s)".

The Examiner simply reads too much into Van Oijen.

With respect to the following limitation of claim 1:

> "performing such a reconfiguration of the printer configuration automatically or providing information to enable such a reconfiguration to be carried out manually."

the examiner points to a passage when a box is clicked for manual operation. See page 6 of the official action. The passage in question is column 5, lines 12-20 of Van Oijen.

Since a box needs to be clicked, it appears that no " reconfiguration of the printer configuration" occurs <u>automatically</u> as set forth in the first half of this limitation and this passage is devoid of any suggestion that Van Oijen's system should provide "information to enable such a reconfiguration to be carried out manually" as claimed. No information to "<u>enable such a recognifuratioin to be carried out manually</u>" is provided as claimed.

Again, the Examiner simply reads too much into Van Oijen.

Claim 12 recites, *inter alia*:

> "when one or more of the print jobs cannot be printed using said printer(s) on the basis of said current printing configuration, to determine automatically at least one reconfiguration of the printer configuration(s) that would be capable of satisfying the printing requirement(s) of said print job(s); and when said reconfiguration would require manual reconfiguration of said printer(s) by a user of the printing system, then use the printing system to generate and present to said user instructions for manually reconfiguring said printer(s) prior to printing of the print job(s) by the printing system."

The Examiner tried to read this passage in much the same way as he tries to read the quoted passages of claim 1 on Van Oijen. But the cited passages in Van Oijen simply fail to meet this limitation. There is no determination "automatically at least one reconfiguration of the printer configuration(s) that would be capable of satisfying the printing requirement(s) of said print job(s)" as claimed in the cited passages and there is no disclosure in the cited passages of use of "the printing system to generate and present to said user <u>instructions for manually reconfiguring said printer(s)</u> prior to printing of the print job(s) by the printing system" as required by this claim.

Claim 13 recites, *inter alia*:

> "when the print job cannot be printed using the one or more printers in their current printing configuration, automatically determine at least one reconfiguration of the one or more printers that would be capable of satisfying the printing requirements of said print job; and providing information to enable such a reconfiguration to be carried out by another."

The Examiner tried to read this passage in much the same way as he tries to read the quoted passages of claims 1 and 12 on Van Oijen. But the cited passages in Van Oijen simply fail to meet this limitation. There is nothing to "automatically determine at least one reconfiguration of the one or more printers that would be capable of satisfying the printing requirements of said print job" as claimed in the cited passages and there is no disclosure in the cited passages of the computer system being programmed for "providing information to enable such a reconfiguration to be carried out by another" as required by this claim.

Claim 14 recites, *inter alia*:

> "when the print job cannot be printed using the one or more
> printers in their current printing configuration, automatically determine
> at least one reconfiguration of the one or more printers that would be
> capable of satisfying the printing requirements of the print job; and
> perform such a reconfiguration of the one or more printers when such
> reconfiguration can be done automatically and providing information to
> enable such a reconfiguration to be carried out by another when such
> reconfiguration cannot be done automatically."

The Examiner tried to read this passage in much the same way as he tries

to read the quoted passages of claims 1, 12 and 13 on Van Oijen. But the cited

passages in Van Oijen simply fail to meet this limitation. There is nothing to

"automatically determine at least one reconfiguration of the one or more

printers that would be capable of satisfying the printing requirements of the

print job" as claimed in the cited passages and there is no disclosure in the cited

passages of a computer program containing code adapted to program one or

more processors of a computer system to "perform such a reconfiguration of the

one or more printers when such reconfiguration can be done automatically and

providing information to enable such a reconfiguration to be carried out by

another when such reconfiguration cannot be done automatically" as required

by this claim.

Even if it is assumed that the disclosures of Owa and Van Oijen can be

combined in some logical fashion, the combination asserted by the Examiner

does not anticipate claims 1, 12, 13 or 14.

But, the Examiner's asserted rationale for combining these references is

also inadequate. Just because they both relate to the printer arts there is no

reason to combine them. That is, with all due respect, mere conclusory

reasoning. There are doubtlessly hundreds of thousands of documents related

to the printer arts and that fact alone does not justify combining any two of

them in some rationale fashion. They must be taken on their own merits. Moreover, as the Examiner points out in the Examiner's reasoning with respect to Van Oijen, "it is checked whether manual or automatic setting is set before manually setting the printer based on the print conditions" (see, e.g., page 6 of the official action). So if Owa prints most jobs automatically, why force a user to make a determination as to whether a print job needs to be done manually before printing them? Isn't that a step backwards in automation? Why do that? It is respectfully submitted that a person skilled in the art would not make this combination. The Examiner makes the combination as the Examiner finds it useful in trying to reject the claims, but no legitimate reason has been brought forth why a person skilled in the art would be motivated to make this combination. This combination arises from applicant's claims as opposed to from what the prior art really teaches.

But, as indicated above, even if the combination is made, it does not lead to applicant's claims.

Withdrawal of the rejections and allowance of the claims are respectfully requested.

The Commissioner is authorized to charge any additional fees which may be required or credit overpayment to deposit account no. 08-2125. In particular, if this response is not timely filed, then the Commissioner is authorized to treat this response as including a petition to extend the time period pursuant to 37 CFR 1.136 (a) requesting an extension of time of the number of months necessary to make this response timely filed and the petition fee due in connection therewith may be charged to deposit account no. 08-2125.

I hereby certify that this correspondence is being
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22 October 2008
(Date of Transmission)

Lonnie Louie
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22 October 2008
(Date)

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